

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

DDC TECHNOLOGY, LLC,
Patent Owner.

IPR2023-00707 (Patent 9,420,075 B2)
IPR2023-00708 (Patent 9,811,184 B2)
IPR2023-00709 (Patent 10,528,199 B2)
IPR2023-00710 (Patent 11,093,000 B2)
IPR2023-00711 (Patent 11,093,001 B1)¹

Before KALYAN K. DESHPANDE, *Vice Chief Administrative Patent Judge*, PATRICK M. BOUCHER, SHEILA F. McSHANE, and JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion for Additional Discovery
35 U.S.C. § 314

¹ We exercise our discretion to issue one Order to be docketed in each of the listed proceedings. Except as expressly authorized by the Board, the parties may not use this caption.

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On June 5, 2023, DDC Technology, LLC (“Patent Owner”) emailed the Board to request authorization to file a motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2) in these five proceedings, noting that Google LLC (“Petitioner”) opposed Patent Owner’s request. *See* Ex. 1014.²

On June 13, 2023, we held a conference call with the parties. *See* Ex. 1013 (transcript). At that time, Patent Owner sought documents related to communications and agreements between Petitioner and Mattel, Inc., MerchSource LLC, Unofficial Cardboard, Inc., and/or Orora Packaging Solutions (“OPS”). *See id.*; *see also* Ex. 1014, 2 (listing requests for production). Patent Owner argued that the requested documents would show that Petitioner is “precluded by the one year time bar from proceeding with these petitions.” *E.g.*, Ex. 1013, 11:22–12:15. After extensive discussion with the parties, we determined that Patent Owner would not satisfy the first factor of the *Garmin* test “based on the information . . . provided on this call today,” and consequently, “the Board would not grant [Patent Owner’s requested] motion for additional discovery.” *Id.* at 37:10–15; *see Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013) (precedential) (*cited in* Ex. 3001 (email scheduling conference call)). Nevertheless, we authorized Patent Owner to file a motion for additional discovery “on these matters” in each of the five proceedings on or before June 27, 2023. *Id.* at 37:22–38:24.

² We cite to papers and exhibits in IPR2023-00707. Substantially similar papers and exhibits were also filed in each of the other proceedings.

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Patent Owner thereafter filed a motion in each of these proceedings. Paper 8 (“Motion” or “Mot.”).³ In the Motion, Patent Owner contends that “*Garmin* factor one is satisfied at least as to OPS” because Patent Owner is in possession of evidence “strongly suggesting” that Petitioner intentionally omitted OPS as “a real party in interest or privity” to “significantly impact the *Fintiv*^[4] analysis.” *Id.* at 1. From this, Patent Owner asserts that “the requested discovery is warranted.” *Id.* Patent Owner also states that, “to the extent the Board denies additional discovery at this time, [Patent Owner] requests the limited relief of compelling [Petitioner] to permit use of [Petitioner’s] documents produced in prior litigations concerning infringement of the patents subject to these IPR proceedings.” *Id.* at 3; *see id.* at 2–3 (indicating that those documents are subject to at least two district court protective orders).

Petitioner timely filed an opposition in each proceeding arguing that Patent Owner’s motion fails both on procedural grounds and on the merits.

³ Patent Owner originally filed a motion in only two of the proceedings (IPR2023-00707 and IPR2023-00708), but a footnote in those documents indicated that Patent Owner misunderstood the Board’s oral order. *See* Mot. 1 n.1. On June 29, 2023, the Board emailed the parties to authorize Patent Owner to file a substantially similar document in the other three proceedings by a revised deadline (Ex. 3002), and Patent Owner filed motions in the remaining proceedings before that deadline. Thus, in this Order, we consider the motions filed in all five proceedings.

⁴ In *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), the Board identified factors that it will address when deciding whether or not to exercise discretion to deny institution considering the status of co-pending litigation.

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Paper 9 (“Opp.”). Petitioner first asserts that Patent Owner fails to “make any specific discovery request as required by the Board’s rules.” *Id.* at 1 (citing 37 C.F.R. § 42.22(a)(1)); *see also id.* at 3. Petitioner also contends that Patent Owner’s motion “improperly raises a new, sweeping request for cross-use of *all* of Petitioner’s documents from *all* prior district court litigations, for which the Board did not grant authorization.” *Id.* at 1; *see also id.* at 3–4. As for the merits, Petitioner argues that Patent Owner fails to address most of the companies discussed during the conference with the Board (*id.* at 5–6), and regarding OPS, Patent Owner fails to explain its theory or provide any evidence to support it, which “is simply not enough to satisfy either 37 C.F.R. § 42.22(a)(2) or *Garmin* factor one” (*id.* at 6–7).

No reply was authorized. *See* Ex. 1013, 38:20–21.

LEGAL STANDARD

A motion “must include: (1) A statement of the precise relief requested; and (2) A full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.” 37 C.F.R. § 42.22(a). In addition, the “moving party has the burden of proof to establish that it is entitled to the requested relief.” *Id.* § 42.20(c).

When requesting additional discovery in an *inter partes* review, a party must demonstrate that “such additional discovery is in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i). In a motion for additional discovery, the Board considers a number of factors, which are often referred to as the

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Garmin factors. *See Garmin*, IPR2012-00001, Paper 26 at 5–7. *Garmin* factor 1 is of particular relevance to this Order:

1. More Than A Possibility And Mere Allegation -- The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.

Id. at 6.

ANALYSIS

Patent Owner’s motion requests two types of relief: (1) additional discovery from Petitioner and (2) in the alternative, an order instructing Petitioner to agree that Patent Owner can use, in these proceedings, the documents previously provided by Petitioner to Patent Owner but which are subject to district court protective orders. For the reasons below, we deny each of these requests both on procedural grounds and on the merits.

Additional Discovery

First, we deny Patent Owner’s Motion because it fails to identify “the precise relief requested,” as required by 37 C.F.R. § 42.22(a). *See* Opp. 3. In its June 5 email to the Board, Patent Owner sought documents relating to Mattel, MerchSource, Unofficial Cardboard, and/or OPS, and it listed seven proposed requests for production. *See* Ex. 1014. The Motion, however, includes *no* reference to any requests for production and fails to otherwise identify the discovery sought by Patent Owner. *See* Mot.

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